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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/600,005

06/20/2003

Rodney Nash

6094

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7590

10/04/2007

EXAMINER

HAMILTON, MATTHEW L

ART UNIT

PAPER NUMBER

3622

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DELIVERY MODE

10/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/600,005

Applicant(s)

NASH, RODNEY

Examiner

Matthew L. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/20/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the initial filing filed on 20 June 2003.
2. Claims 1-6 are currently pending and have been examined.

Information Disclosure Statement

3. The Information Disclosure Statement filed on 20 June 2003 has been considered. An initialed copy of the Form 1449 is enclosed herewith.
4. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Specification

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.
6. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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7. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For examination purposes the Examiner interprets the claims as follows:

Claim 1:

- a. Issuing consumers a magnetic card, smart card or biometric card for promotional and identification purposes.
- b. Allowing manufacturers to upload and download discounts and data to the discount database.
- c. Allowing retailers to upload and download discounts and data to the discount database.
- d. Allowing consumers to use the magnetic cards, smartcards or biometric cards at point of sale terminals.
- e. Allowing consumers to access the retailer website for additional discounts by providing identification information.
- f. Scanning item UPC data at point of sale terminals.

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Claim 2:

A network is used to send product and discount information.

Claim 3:

A database is used to update, receive, store and transmit information.

Claim 4:

Providing reports, discount notifications and authorizations to retailers and manufacturers.

Claim 5:

Providing authorization of electronic transfer of funds to occur at the point of sale terminal computer.

Claim 6:

Manufacturers providing reimbursements to retailers for accepting manufacturers discounts.

10. The claims are generally narrative and indefinite, failing to conform with current U.S. practice, are replete with grammatical and idiomatic errors.

11. Regarding claim 2, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

12. Regarding claims 1 and 3 the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

13. Claims 1, 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

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invention. The above claims use the acronyms ANSI, ADSL, POS, UPC, APCS, ISO, TCP/IP, HGEPOS and ACS without providing their textual meaning as required. For Examination purposes, the Examiner will interpret American National Standards Institute (ANSI), Asymmetric Digital Subscriber Line (ADSL), Point Of Sale (POS), Universal Product Code (UPC), Association for Payment Clearing Services (APCS), International Standards Organization (ISO), Transmission Control Protocol/Internet Protocol (TCP/IP). The meanings for HGEPOS and ACS are unknown.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Day et al. US Patent 5,857,175 in view of Kepecs US Patent 6,009,411.

Claim 1:

As per claim 1, Day teaches a method comprising:

- a) Issuing or associating consumers with a magnetic card, smart card or biometric card for promotional and identification purposes. (Day column 4, lines 33-41);
- b) Allowing manufacturers to upload and download discounts and data to the discount database. (Day column 3, lines 25-28 and lines 57-64);
- c) Allowing retailers to upload and download discounts and data to the discount database. (Day column 3, lines 25-28 and lines 57-64);

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d) Allowing consumers to use the magnetic cards, smartcards or biometric cards at point of sale terminals. (Day column 4, lines 25-28 and column 6, lines 13-15);

Day does not teach e) Allowing consumers to access the retailer website for additional discounts by providing their identification information. However, Kepecs teaches a method and system for distributing and reconciling electronic promotions in column 1, lines 6-11 and further teaches *"In general terms and in accordance with the present invention, consumers communicate with an Electronics Discount Administrator (DAP) over the Internet. Each consumer identifies him or herself to the DAP by a unique KEY, which provides an identification of the consumer to the DAP..."* and *"The DAP makes the consumer aware of discounted and promotional items, which have been made available by discounting entities (the discounters), which offer the discounts to the consumer. A discounter may be one or more direct producers, such as cereal makers; repackagers, such as stores offering products manufactured by producers under the stores' names; or stores which offer many discounted products which the stores resell."* (Kepecs, column 3, lines 50-54 and lines 56-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Day to allow consumers to access the retailer website for additional discounts by providing their identification information. One would have been motivated to allow consumers to access the retailer website for additional discounts by providing their identification information in order to identify the consumer, provide the consumer the freedom to select the discounts available and provide a historical account of the discounts provided to the consumer.

f. Scanning item UPC data at point of sale terminals. (Day column 4, lines 25-33 and column 5, lines 10-19).

Claim 2:

As per claim 2, Day in view of Kepecs teaches the method of claim 1 as described above and further teaches a network is used to send product and discount information (Day column 4, lines 25-33 and column 5, lines 10-19).

Claim 3:

As per claim 3, Day in view of Kepecs teaches the method of claim 1 as described above but does not teach *a database is used to update, receive, store and transmit information*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention for Day include a database to update, receive, store and transmit information. The database primary functions are to update, receive, store and transmit information.

16. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Day et al. US Patent 5,857,175 in view of Kepecs US Patent 6,009,411 and further in view of Granger WO 95/30199.

Claim 4:

As per claim 4, Day in view of Kepecs teaches the method of claim 1 as described above. Day in view of Kepecs does not teach *providing reports, discount notifications and authorizations to retailers and manufacturers*. However, Granger teaches a method and apparatus for electronically clearing and processing bar-coded discount coupons in page 1, lines 6-7 and further teaches "...processing the coupon data to yield timely manufacturer and retailer invoices and reports; and effecting payment of the retailers by manufacturers for redeemed and validated coupons. The invention provides for virtually automatic payments to the retailers based on an electronic coupon count and only a single physical coupon count, and using an extremely robust validation procedure in stores..." (Granger, page 4, lines 23-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Day to provide report, discount notifications and authorizations to retailers and manufacturers. One would have been motivated to provide report, discount notifications and

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authorizations to retailers and manufacturers in order to keep a log of the discounts authorized consumers and properly recompense the retailers for allowing manufacturer coupons.

Claim 5:

As per claim 5, Day in view of Kepecs teaches the method of claim 3 as described above. Day in view of Kepecs does not teach *providing authorization of electronic transfer of funds to occur at the point of sale terminal computer*. However, Granger teaches a method and apparatus for electronically clearing and processing bar-coded discount coupons in page 1, lines 6-7 and further teaches "*The fault-tolerant CPU 24 communicates with disk storage in which coupon databases 26 are created and maintained, control terminals 28, a communication interface 30 for connection to the communication lines 20, and appropriate interfaces 32 for communicating with a bank 34 or other financial institution to perform electronic funds transfer (EFT).*" (Granger, page 10, lines 3-7). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Day to provide authorization of electronic transfer of funds to occur at the point of sale terminal computer. One would have been motivated to provide authorization of electronic transfer funds at the point of sale terminal computer in order to move funds from payer to a payee through a banking system for the payment of goods and services.

Claim 6:

As per claim 6, Day in view of Kepecs teaches the method of claim 3 as described above. Day in view of Kepecs does not teach *manufacturers providing reimbursements to retailers for accepting manufacturers discounts*. However, Granger teaches a method and apparatus for electronically clearing and processing bar-coded discount coupons in page 1, lines 6-7 and further teaches "...*processing the coupon data to yield timely manufacturer and retailer invoices and reports; and effecting payment of the retailers by manufacturers for redeemed and validated coupons. The invention provides for virtually automatic payments to the retailers based on an electronic coupon count and only a single physical coupon count, and using an extremely robust validation procedure in stores...*" (Granger, page 4, lines

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23-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Day for manufacturer to provide reimbursements to retailers for accepting manufacturers discounts. One would have been motivated for the manufacturers to provide reimbursements to retailers for accepting manufacturers discounts in order to make up for discounts and savings passed on to the consumers.

Conclusion

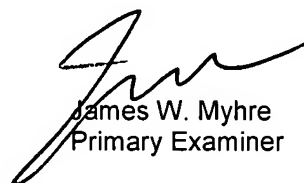
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Hamilton whose telephone number is (571) 270-1837. The examiner can normally be reached on Monday-Friday 7:30a.m-5p.m EST alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew Hamilton
Patent Examiner

September 25, 2007



James W. Myhre
Primary Examiner